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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,806	10/21/2003	Steven P. Barton	112703-294	6662

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EXAMINER
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SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/691,806

Applicant(s)

BARTON ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-68,76 and 102-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-68,76 and 102-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/20/06 &amp; 5/30/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Prosecution on the merits of this application is reopened on Claims 44-68, 76 and 102-111 as Applicant's Appeal Brief filed on 8/22/06, was found persuasive.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 62-64 is rejected under 35 U.S.C. 102(e) as being anticipated by Terranova.

Terranova discloses a point of purchase device (18) in the form of a fuel dispenser that is coupled with a retail purchasing device in the form of quick serve (QSR) menu, as discussed at col. 11, lines 25-35. Regarding obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed, note that it is considered to be inherent that the owner of Terranova's gas station would obtain a fee in the form of profits for selling a particular item through Terranova's system.

Regarding Claim 63, note that the entire point of purchase device is disclosed as being "integral" with the resale purchasing device since the QSR menu is displayed on the fuel dispenser display. See again, col. 11, lines 25-35.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 44-68, 76 and 102-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bustos (US 5,816,443) in view of Walter et al (US 5,992,570) and further in view of Terranova (US 6,882,900 B1). Bustos discloses the following.

As described in Claims 44, 48-50, 56, 62-65, 67, 76 and 102-111;

- a. allowing a consumer to bring purchasable items to a checkout device (see Bustos, fig. 5a);
- b. scanning the items and accumulating a cost for the scanned items on a display (127), as illustrated in Bustos, fig. 1, and fig. 5a, which illustrates a clerk scanning items, and figure 5d, which illustrates a monitor (106);
- c. allowing the consumer to select a product (47b) from a dispensing device (20b) located in juxtaposition to the automated checkout (see Bustos, fig. 5a);
- d. automatically dispensing the product from the dispensing device in response to the consumer's selection (see Bustos, fig 5a); and
- e. adding a cost of individual items to the total cost for the scanned items on the display (see Bustos, col. 8, lines 1-49);

Bustos does not expressly disclose, but Walter discloses the following.

As described in Claims 44, 48-50, 56, 62-65, 67, 68, 76 and 102-111;

- f. allowing a consumer to bring purchasable items to an *automated* checkout device (10) (see Walter, col. 2, lines 15-19, for example);
- gi. allowing the consumer to scan the purchasable items and accumulate a cost for the scanned items on a display; (see Walter, Claim 8, for example);
- gii. (68) the point of purchase dispenser is integral with the device that identifies costs-note that Walter discloses scanner (16);

Bustos does not expressly disclose, but Terranova discloses the following.

As described in Claims 44, 47-51, 56, 60-66, 76 and 102-111;

- ei. automatically adding a cost of the dispensed product to the total cost of the scanned items on the display.
- eii. accepting a single payment for all items, including the dispensed product;

See Terranova, col. 8, line 64-col. 9, line 19 and col. 11, lines 25-35.

As described in Claim 45, 48;

- h. use of a touch screen as the display (100);

See Terranova, col. 7, lines 23-29.

As described in Claims 46 and 104;

- i. allowing the customer to pay for the product using a credit/debit card or cash;

See Terranova, col. 1, lines 47-50.

As described in Claims 49, 50, 52, 53, 56, 57, 65

- j. advertising/prompting a customer to add a dispensable product to their purchase;

See Terranova, col. 8, line 64-col. 9, line 19.

Regarding Claim 53, note that Terranova discloses advertising, but does not specify the time period at which it is presented. However, note that the group of time periods presented in Claim 53 covers all conceivable time periods with respect to the transaction. Therefore, since Terranova discloses presenting advertisements with respect to the transactions, Terranova is considered to meet Claim 53.

Further regarding Claims 54, 55, 58, 59 and 106, note that it would have been obvious for either an operator to substitute for a customer in operating the machine, taking verbal instruction from said customer, or for the customer himself to perform the task.

Regarding Claim 60, note that Terranova discloses purchasing items at a convenience store, which is considered to include both consumables, such as food, as

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well as non-consumables, such as lighters and windshield scrapers. Note also that a food item that is not consumed, becomes a non-consumable item.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have replaced the checkout counter of Bustos with the checkout counter of Walker.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

Further, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated the interface having the features discussed above, as taught by Terranova, in Bustos' checkout counter with dispenser, so that a customer using Bustos' self-checkout would be able to dispense an item, the cost of which was automatically added to the total of all items purchased at the checkout counter.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

Note also that Bustos provides motivation and teaching for locating an item dispenser at a checkout counter/point of sale (POS).

Walter provides teaching to use a self checkout system in place of a traditional checkout counter with clerk/operator.

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Terranova discloses an interface for a customer operated point of sale device which promotes and allows the customer to purchase other items/services at the single POS device.

Based on these teachings, one ordinarily skilled in the art would have found it obvious to incorporate Bustos' dispenser and checkout counter as a self-checkout counter having a display which displays a user interface allowing purchase of the dispensed items during the purchase transaction of other items that have been scanned.

Therefore, the combination of Bustos, Walter and Terranova are considered to read on Applicant's claims as discussed above.

### ***Response to Arguments***

6. Applicant's arguments with respect to Claims 44-68, 76 and 102-111 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Bustos teach away from an automated checkout. However, Bustos can be construed to be an automated checkout. Bustos states in col. 8, lines 1-5 that the customer may add to his gasoline purchase the selection and purchase of a beverage. Col. 8, lines 9-14 indicate that the billing system communicates with the gasoline vending system as well as the dispensers (20). Based on lines 1-5, one of ordinary skilled in the art would have recognized that the vending unit located next to the point of sale or at the cash register. Also, col. 8, lines 42-49 clearly indicate that "a product order can be processed from a selection on the panel



(22), charging the price directly to the pending transaction being processed at the checkout lane cash register.”

Walter discloses a self-service checkout system. Based on the teaching of Walter, it would have been obvious to one ordinarily skilled in the art to have substituted a manually operated cashier station with a self-service checkout system, so as to automate checkout operations, thereby reducing the need for employees. See the discussions outlined above.

Regarding the argument that Bustos discloses remote storage versus storage of items on or at the point of sale, at the very least, it would have been obvious to reduce the length of pipe from the storage device located on the ceiling, as shown in Bustos, figure 1. Further, one could construe the storage unit (25) of Bustos as being located proximate, since it is within the same building rather than outside the building (15). In other words, the term “proximate” versus “remote” are very broad terms that can be construed such that Bustos’ storage area can be read as being “proximate” to the checkout (24). Regarding applicant’s argument that Bustos does not prompt the consumer to purchase a product from the dispensing device, see Bustos, figure 5D, which shows in inset, upper left-hand corner, menu (106), which can be construed to “prompt” the consumer to purchase a particular item located on the menu. Again, Applicant’s claim limitations are sufficiently broad so as to invite such interpretations. Regarding Walter, note that Walter is only being used for its teaching of automating a manually staffed checkout counter with an automated self-checkout counter. Bustos provides the teaching for dispensing products at a point of purchase and combining the

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cost of those items with other items purchased. Again, note the gasoline example cited above. Regarding consumable versus non-consumable items, it is construed that regardless of the status of the item, the system will work equally the same with either consumable or non-consumable items.

Newly cited Terranova provides further teaching, motivation and suggestion for adding the cost of the dispensed item to the total cost of all items included in the transaction. See again, rejection discussed above.

Therefore, Claims 44-68, 76 and 102-111 are rejected.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chandonnet '009 (US), Schindler '561 (Europe) and Harting '164 (German) are all cited as examples of item dispensers integrated with point of sale devices.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JAS

November 26, 2006

  
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